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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT

PAPER NUMBER

2656

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,595

Applicant(s)

OKAMOTO ET AL.

Examiner

Jorge L. Ortiz-Criado

Art Unit

2656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted amended claims 12-14, 16-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Previously presented claims 12-28 drawn to a disk-shaped recording medium.
- II. Currently submitted claims 12-14, 16-28 claims drawn to a reproducing apparatus for reproducing a disk shaped writable recording medium.
- III. Currently submitted claim 29, drawn to reproducing apparatus for reproducing a disc-shaped recording medium.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because does not required a disk-shaped recording medium comprising a primary recording region for recording a data signal based on a user instruction and a secondary recording region which is located on the side of an internal periphery of said primary recording region, wherein in said primary recording region the data signal is recorded, and wherein said

Art Unit: 2656

secondary recording region has information pits formed to record signal representative of primary control information as data, wherein said primary recording region has a track which wobbles at a first pitch and wherein said secondary recording region has a track which wobbles at a second pitch different from said first pitch.. The subcombination has separate utility such as store recorded data information to be reproduced.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as having a means for shifting the pickup, and having a means for distinguishing if a reproduction location of said recording medium is the track which wobble at a first pitch of the track which wobbles at a second pitch different for the first pitch, and a system controller for wherein at the time when said reproducing apparatus is initially actuated to reproduce said data signal from a track, said controller determines whether said track wobbles at said first pitch, and if so, shifts said pickup until said track wobbles at said second pitch., whereupon a primary control information in a secondary recording region is first reproduced. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-14 and 16-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites in the preamble “A reproducing apparatus for reproducing a disc-shaped writable recording medium, comprising” and further “ and a reproducing apparatus for the reproduction ...” at line 15.

It is unclear what the Applicant is trying to encompass with this terminology. Applicant cooperation is respectfully requested.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2656

4. Claim 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in combination with Lokhoff et al. U.S. Patent No. 5,060,219 and further in view of Timmermans et al. U.S. Patent No. 5,930,210.

The admitted prior art discloses a disk-shaped recording medium comprising a primary recording region for recording a data signal based on a user instruction and

and a secondary recording region which is located on the side of an internal periphery of said primary recording region, wherein in said primary recording region the data signal is recorded, and wherein said secondary recording region has information pits formed to record signal representative of primary control information as data (see page 1, line 20 to page 2 lines 11);

wherein said primary control information in said secondary recording region includes an invalid key information item/"genuine control information"/ for inhibiting reproduction of main data encrypted in said primary recording region by using "secondary control information"/ "control information including key information item and identification information item" illegally recorded in said primary recording region (see page 2, line 3- 20)

said "secondary control information" comprising information for decrypting said main data encrypted in said primary recording region (see page 1, line 25-26 and page 2, lines 9-14)

The admitted prior art fails to disclose wherein said primary recording region has a track which wobbles at a first pitch and wherein said secondary recording region has a track which wobbles at a second pitch different from said first pitch.

Lokhoff et al. discloses a disk-shaped recording medium (See col. 6, lines 20-22) comprising: a primary recording region (See Fig. 3a, 3e)

Art Unit: 2656

and a secondary recording region which is located on the side of an internal periphery of said primary recording region (See Fig. 3a, 3c),

wherein said primary recording region has a track which wobbles at a first pitch/frequency and along which a user is able to record a data signal (See col. 6, lines 33-35; Fig. 3a, 3e);

and wherein said secondary recording region has a track which wobbles at a second pitch/frequency different from said first pitch/frequency and along information pits are formed to record signal representative of control information as data (See col. 2, lines 50-58; col. 6, lines 20-35. lines 56-63; Fig. 3a, 3c, 3e).

Lokhoff et al. teaches using the “pitch/frequencies/wobbles/sinusoidal undulation” of the track for the first and second recording regions to determine the position of the track to be scanned. Lokhoff et al. further teaches wherein the control information in said secondary recording region is for inhibit/disabling/enabling/ operations indicated by the control information being read from the recording medium (See col. 1, lines 40-55; col. 2, lines 50-58)

Timmermans et al, teaches a recording medium which includes a tracks having which wobbles at predetermined a pitch/frequency along information pits are formed to record data signal (see col. 6, lines 12-56; Fig. 1a-1b)

a reproducing apparatus for reproduction of main data recorded in said primary recording region of said recording medium (See Timmermans et al. col. 5, lines 13-25; Figs. 1a, 1b, 1c, 3, 5), said reproducing apparatus comprising:

a pickup for reading a signal from said recording medium under rotation (See Timmermans et al. col. 5, lines 30-34; Fig. 5, Ref# 52)

Art Unit: 2656

means for shifting said pickup (See Timmermans et al. col. 5, line 53 to col. 6, line 1-56; Fig.5 Ref# 60)

means for distinguishing if a reproduction location of said recording medium is the track which wobbles as said first pitch or the track which wobbles at said second pitch different from said first pitch (See Timmermans et al. col. 5, line 53 to col. 6, line 1-56; Fig.5 Ref# 60);

a controller (44) connected to said pickup , said shifting means and said distinguishing means, wherein at a time when said reproducing apparatus s initially actuated to reproduce said data signal from a track, said controller determines whether said track wobbles at said first pitch and if so, shifts said pickup until said track wobbles at said second pitch, whereupon said primary control information in said secondary recording region is first reproduced, and the reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region is inhibited by the invalid key information item included in said primary control information in said secondary recording region (See Timmermans et al. col. 5, line 53 to col. 6, line 1-56; Fig.5 Ref# 60); (See Timmermans et al. col. 6, line 45 to col. 7, line 21; Fig. 5,Ref# 61,62; only reproducing the track with the predetermined pitch/frequency, recovering the genuine control information in the secondary region of the admitted prior art R disk)

It would have been obvious to one with ordinary skill in the art at the time of the invention to provide the primary recording region with a track which wobbles at a first pitch/frequency and the secondary recording region with a track which wobbles at a second pitch/frequency different from said first pitch, because by doing that provides detection of position of the region and track

Art Unit: 2656

portion to be reproduced/scanned as taught by Lokhoff et al., and further enabling recovering/reproducing of the tracks having a predetermined pitch/frequency and that in the case of the absence of the predetermined pitch/frequency the recovery/reproduction is disable as taught by Timmermans et al, by doing so it would disable the recovery/reproduction of the “secondary control information illegally recorded/not genuine information” in the primary recording region and enabling reproduction/recovering of the genuine control information in the secondary recording region.

Response to Arguments

Applicant's arguments filed 10/13/2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case the rejection is claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in combination with Lokhoff et al. further in view of Timmermans et al.

Aapplicant's admitted prior art in combination with Lokhoff et al. teach a recording medium a disk-shaped recording medium comprising a primary recording region and a secondary recording region which is located on the side of an internal periphery of said primary recording

Art Unit: 2656

region, wherein said primary control information in said secondary recording region includes an invalid key information item/"genuine control information"/ for inhibiting reproduction of main data encrypted in said primary recording region by using "secondary control information"/ "control information including key information item and identification information item" illegally recorded in said primary recording region said "secondary control information" comprising information for decrypting said main data encrypted in said primary recording region and wherein said primary recording region has a track which wobbles at a first pitch/"**frequency**" and wherein said secondary recording region has a track which wobbles at a second pitch/"**frequency**" different from said first pitch.

And further in combination with the teachings of Timmermans et al., which teach enabling recovering/reproducing of the tracks having a predetermined pitch/frequency and that in the case of the absence of the predetermined pitch/frequency the recovery/reproduction is disable, which by doing so it would disable the recovery/reproduction of the "secondary control information illegally recorded/not genuine information" in the primary recording region and enabling reproduction/recovering of the genuine control information in the secondary recording region.

Furthermore, Applicant argues that there is no suggestion to combine of a system comprising a disk-recording medium in combination with a reproducing apparatus wherein the reproducing apparatus first reproduces data on a secondary region of the disk-shaped recording medium in order to first reproduce primary control information.

First, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

Art Unit: 2656

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, at least Applicants admitted prior art teaches that is possible to take other countermeasures against unauthorized copying. For example at the time of the manufacture of an R disk, **Invalid key information is recorded in a secondary recording region** of that R disk and identification information indicating that the disk concerned is not a RUM disk but an R disk is recorded also in the secondary recording region which is read first at the time of seeking for the of such secondary recording region to be reproduced first, also Timmermans et al. specifically teach and suggest recover recovering a key information item by enabling recovering/reproducing of the tracks having a predetermined pitch/frequency and that in the case of the absence of the predetermined **pitch/frequency** the recovery/reproduction is **disable**.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2656


CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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